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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,485

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Raphael Cohen

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EXAMINER

REESE, DAVID C

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3677

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,485	<b>Applicant(s)</b> COHEN, RAPHAEL	
	<b>Examiner</b> DAVID C. REESE	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/2009 has been entered. Consequently, the following is the current listing of claims in the instant application:

### ***Status of Claims***

- Claims 2-3, 5-16 were canceled.
- Claims 17-19 were added.
- Claims 1 and 17 were amended.
- Claims 1, 4, and 17-19 are pending.

### ***Information Disclosure Statement***

[1] The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

[2] The disclosure is objected to because of the following informalities:

There are no section headings present (see below). Appropriate correction is required.

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The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

[3] The abstract of the disclosure is objected to because it uses claim terminology such as "consisting of" (see below). Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

[4] Claim(s) were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 5/1/2009. Accordingly, the objection(s) to the claim(s) have been withdrawn.

However, as amended:

[5] Claim 1 recites the limitation "the visible portion" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[7] Claims 1, 4, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leveridge, FR-585,940, in view of Pollack, US-5,423,196, in further view of Monnier, US-2,207,869.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Leveridge discloses of an item of jewelry (see figs. 4-5) consisting of a central stone (3), the central stone (3) comprising a pavilion, a crown having a plurality of crown facets and a table and having the shape of a regular polygon, the polygon having a plurality of sides when observed from the table of the central stone (3), and a corresponding plurality of peripheral stones (1, 2), arranged around the central stone with the length of an edge of one of the sides of each of the peripheral stones being identical to the length of one of the sides of the regular polygon, wherein the central stone (3) and the peripheral stones (1,2) are arranged on a support comprising a first ring (8) concentric with and connected to a second ring (6) having a top edge, said second ring (6) extending continuously around the circumference of the second ring (6), each peripheral stone (1,2) also being located in position by a slot (see 8 in fig. 2) formed on the inside of the perimeter of the first ring (8), to simulate the appearance of the crown of a stone larger than the central stone.

Though Leveridge teaches of a second ring (6) having a top edge with said ring extending continuously around the circumference of the central stone, the difference between the claim and Leveridge is that Leveridge does not expressly state that of a T-shaped shoulder on said top edge, the T-shaped shoulder extending continuously around the circumference of the second ring, with one side of the T-shaped shoulder being configured to be snapped into a longitudinal groove extending entirely around the circumference of the pavilion of the central stone and with the other side of the T-shaped shoulder being snapped into a groove present in each peripheral stone; and of the at least one facet of each peripheral stone having an angle of

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incidence to the table of the central stone equal to the angle of incidence of an adjacent crown facet to the central stone; and that the visible portion of each peripheral stone being divided into three triangular peripheral stone facets,

With regard to the former issue, Pollack discloses a gemstone setting similar to that of Leveridge. In addition, Pollack further teaches of the setting having multiple channels having T-shaped shoulders (32) on its top edge, with one side designed to be snapped into a corresponding longitudinal groove passing of one stone and its other side snapped into a groove present in another adjacent stone (see fig. 2) along the entire length of the channel (see abstract). It would have been obvious to one of ordinary skill in the art, having the disclosures of Leveridge and Pollack before him at the time the invention was made, to modify the central ring setting, 6, that extends continuously around the circumference of the central ring of Leveridge to include a T-shaped shoulder along its entire length, as in Pollack. One would have been motivated to make such a combination because such a configuration allows for an alternative means for setting the central and peripheral stones, said configuration fixing the gemstone or gemstones in a manner which is very secure and stable and in which the setting is also substantially invisible, as taught by Ramot (see background of the invention, "attractive and highly desirable"...). Further, it would have been obvious to a person of ordinary skill in the art to have modified the central ring as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the T-shape as claimed has the properties predicted by the prior art of Pollack, it would have been obvious to modify the central ring of Leveridge in order to gain the commonly understood benefits and applications of such an adaptation and/or modification including that of a more stable and secure connection as well as helping to further

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hide said setting from view from the user. Thus, Leveridge as modified by Pollack teaches of the central ring 6 of Leveridge as having a T-shaped shoulder at its top and along the length of the ring/channel as shown by Pollack, said central stone and the adjacent side of the peripheral stones being connected by said T-shaped shoulder. Further, though Leveridge does not disclose of the central stone having a groove passing all the way around the circumference its pavilion, after modification of the second ring, 6, of Leveridge, for proper placement of the central gemstone 5 within the channel, it would have been obvious to one skilled in the art to have modified the central stone of Leveridge as well incorporating a groove passing all the way around the circumference of its pavilion so as to match accordingly with the modified T-shaped second ring.

With regard to the second issue, Monnier discloses a gemstone setting similar to that of Leveridge in view of Ramot. In addition, Monnier further teaches table of each peripheral stone and one of the facets of the crown of the octagonal central stone have an identical angle of incidence (see fig. 7 of Monnier). It would have been obvious to one of ordinary skill in the art, having the disclosures of Leveridge in view of Pollack and Monnier before him at the time the invention was made, to modify the angle at which the central and peripheral stones are arranged with respect to one another to have each peripheral stone and one of the facets of the crown of the central stone to have an identical angle of incidence, as in Monnier. One would have been motivated to make such a combination because one would want that exact design configuration for mere user preference and aesthetics; giving the effect of an extension of the central stone, as taught by Monnier (see col. 1, lines 30-35).



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Lastly, with regard to the third issue above, that is of the visible portion of each peripheral stone being divided into three triangular peripheral stone facets, the examiner takes official notice that it is old and well known to use any type and/or number of facets when a user is designing the shape of a gemstone to be placed within a setting. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the trapezoidal peripheral stones disclosed by Leveridge composed of solely three triangular shaped facets for mere user aesthetic and design preferences.

Re: Claim 4, Leveridge teaches that the central stone is an octagonal stone and the plurality of peripheral stones comprises eight trapezoidal stones arranged around it (see fig. 5).

Re: Claim 17, Leveridge teaches wherein each crown facet (3) and a facet of a corresponding adjacent peripheral stone (1, 2), considered together, simulate a bezel facet of a brilliant-cut stone, wherein said simulated bezel facet is a diamond-shaped facet comprised of said crown facet (3) and said peripheral stone facet (1,2) positioned together.

Re: Claim 18, Leveridge teaches wherein the first ring (8) and the second ring (6) are both circular (see figs. 4-5).

Re: Claim 19, Leveridge in view of Pollack teach wherein the first ring (8) and the second ring (6) have bases and the first (8) and the second ring (6) are connected at their bases by a number of converging arms arranged at regular intervals around the rings (8, 6).

### ***Response to Arguments***

[8] Applicant's amendment and remarks filed 5/1/2009 regarding rejections under 35 U.S.C. 103 have been fully considered. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Leveridge, FR-585,940, in view of Pollack, US-

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5,423,196, in further view of Monnier, US-2,207,869. Consequently, all arguments are considered moot to said new grounds of rejection. Briefly, however, the examiner would like to address applicant's arguments concerning that it would not be obvious to modify Leveridge to incorporate different features because doing so would markedly change the physical structure of Leveridge. In response, the examiner would like to articulate the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

The determining of obviousness does not require staying within the object of Leveridge. "The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007). In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct. at 1742. 82 USPO2d at 1397.

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***Conclusion***

**[9] THIS ACTION IS NON-FINAL**

**[10]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David C Reese/

Examiner, Art Unit 3677